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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jeffrey Niederst

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EXAMINER

LIGHTFOOT, ELENA TSOY

ART UNIT

PAPER NUMBER

1715

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,900	<b>Applicant(s)</b> NIEDERST, JEFFREY	
	<b>Examiner</b> ELENA Tsoy LIGHTFOOT	<b>Art Unit</b> 1715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 11-13, 20 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-19, 21-26 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

Amendment filed on March 30, 2010 has been entered. Claims 1-31 are pending in the application. Claims 11-13, 20, and 27-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims examined on the merits are 1-10, 14-19, 21-26, and 31.

***Abstract***

1. The corrected abstract of the disclosure filed on March 30, 2010 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "VM&P naphtha". According to MPEP 2173.05(u), if the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as

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an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

### **Applicant's arguments**

Applicants argue that the rejection should be withdrawn because the term VM&P naphtha is commonly used in the art to identify a specific aliphatic hydrocarbon having identifiable properties.

The argument is unconvincing because all trademark or trade names are commonly used in the art to identify specific materials. However, MPEP 2173.05(u) prohibits their use in claims.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10, 18, 22-26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over An et al (US 20020172760) in view of Watt (US 3936557).

An et al in view of Watt is applied here for the same reasons as set forth in paragraph 5 of the Office Action mailed on 11/19/2009.

As to amendment, An et al teaches that the invention generally relates to a process and an apparatus useful in the manufacture of can ends used in the **food and beverage** packaging industry (See P3).

### **Applicant's arguments**

(A) Applicants argue that the rejection should be withdrawn because the '760 publication discloses an example of a commercially available radiation curable composition by trademark only. The '760 publication fails to disclose whether the radiation curable composition is suitable for food and beverage can ends, and provides no teaching or suggestion as how to design a composition suitable for such use.

The Examiner respectfully disagrees with this argument. First of all, in contrast to Applicants assertion, the '760 publication teaches expressly that a radiation curable repair agent is suitable for food and beverage metal can ends (See P3). Second, the '760 publication does not limit its teaching to specific radiation curable repair agents for the use in **food and beverage** packaging industry. In other words, any radiation curable compositions having *excellent adherence* to metals and *excellent resistance to most solvents and chemicals* are suitable in the '760 publication. Therefore, a radiation curable composition of the '557 patent having **superior adhesion to metal and excellent resistance to most solvents and chemicals** is suitable in the '760 publication. It is held that the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07. Therefore, one of ordinary skill in the art would have clear motivation to use photocopolymerizable compositions of the '557 patent as radiation repair agent of the '760 publication.

(B) Applicants argue that the '557 patent fails to teach or suggest the polyfunctional reactive diluent recited in the present claims although the examiner contends that a polyglycidyl ether is a claimed polyfunctional reactive diluent having at least two functional groups and **capable of reacting with epoxy or vinyl groups of the difunctional compound** (emphasis is added by the Examiner). In the present application, the difunctional compound is a diepoxy compound, a divinyl compound, or a vinyl epoxy compound. The polyglycidyl ether of the '557 patent therefore is a difunctional compound, not a polyfunctional reactive diluent as asserted by the examiner. Further, the polyglycidyl ether of the '557 patent would not react with the diglycidyl-bisphenol A resins of the '557 patent because both compounds contain epoxy groups. Accordingly, the polyglycidylether does not fall within the definition of a present polyfunctional reactive diluent (see specification, page 16, lines 14-20). The '557 patent therefore fails to teach or suggest every element of the composition recited in the claims.

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The Examiner respectfully disagrees with this argument. First of all, it is noted that the features upon which applicant relies (i.e., polyfunctional reactive diluent having at least two functional groups that *are capable of reacting with epoxy or vinyl groups of the difunctional compound*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, in contrast to Applicants assertion, the examiner didn't contend that polyfunctional reactive diluent having at least two functional groups are capable of reacting with epoxy or vinyl groups of the difunctional compound. Third, the epoxy prepolymer of the type of diglycidyl-bisphenol A resins as shown at column 2, line 64 contains **two epoxy** groups, as required by claimed difunctional compound, and also contains **OH** groups that are capable of reacting with the polyglycidyl ether.

6. Claims 1-10, 14-19, 21-26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over An et al '760, as applied above, and further in view of Smith (US 4256828) for the reasons of record set forth in paragraph 6 of the Office Action mailed on 11/19/2009.

#### **Applicant's arguments**

Applicants argue that the rejection should be withdrawn because the '760 publication fails to provide any information with respect to (a) the components of the composition used as a repair agent, (b) whether the repair agent is suitable for food and beverage metal can ends, or (c) the components needed to provide a repair agent useful for food and beverage metal can ends. At column 12, lines 46-65, the '828 patent discloses a variety of uses for the cured compositions, including resistant images, offset plates, printed circuitry, decorations, stencil marking, and lithography. The '828 patent discloses that the cured compositions can be used as a way of a number of substrates including metal, plastic, paper, glass, rubber, wood, and ceramics. The '828 patent fails to provide any teaching or suggestion as to photocurable compositions suitable for food and beverage metal can ends. In view of the sparse teachings of the '760 publication, i.e., a single commercial product, and the broad teachings of the '828 patent, a person skilled in the art could not pick and choose the components needed to arrive at a food and beverage metal can end composition, as presently claimed.

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The Examiner respectfully disagrees with this argument. First of all, in contrast to Applicants assertion, the '760 publication teaches expressly that a radiation curable repair agent is suitable for food and beverage metal can ends (See P3). Second, the '760 publication does not limit its teaching to specific radiation curable repair agents for the use in **food and beverage** packaging industry. In other words, any radiation curable compositions having excellent adherence to metals are suitable in the '760 publication.

Third, in contrast to Applicants assertion that at column 12, lines 46-65, the '828 patent discloses a variety of uses for the cured compositions, including resistant images, offset plates, printed circuitry, decorations, stencil marking, and lithography, at column 12, lines 46-65, the '828 patent teaches that the photocopolymerizable compositions are particularly suitable in a variety of applications in the fields of **protective coatings** and graphic arts due to their superior impact resistance and abrasion-resistance and ***adhesion to*** rigid, resilient and flexible substrates such as ***metal***, plastic, rubber, glass, paper, wood, and ceramics; ***their excellent resistance to most solvents and chemicals***; and their capability of forming high resolution images. Therefore, one of ordinary skill in the art would have clear motivation to use photocopolymerizable compositions of the '828 patent as radiation repair agent of the '760 publication.

7. Claims 1-10, 14-19, 21-26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over An et al '760, as applied above, and further in view of Koleske (US 5043221) for the reasons of record set forth in paragraph 7 of the Office Action mailed on 11/19/2009.

#### **Applicant's arguments**

Applicants argue that the rejection should be withdrawn because the '760 publication fails to provide any information with respect to (a) the components of a composition used as a repair agent, (b) whether the repair agent is suitable for food and beverage metal can ends, or (c) the components needed to provide a repair agent useful for food and beverage can ends; and the '221 patent is directed to compositions useful as a coating on circuit boards, electrical components, specialty metals, ceramics,

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plastics, and composites (column 1, lines 62-68). The reference is not remotely related to a composition useful in a method of coating food and beverage metal can ends.

The Examiner respectfully disagrees with this argument. First of all, in contrast to Applicants assertion, the '760 publication teaches expressly that a radiation curable repair agent is suitable for food and beverage metal can ends (See P3). Second, the '760 publication does not limit its teaching to specific radiation curable repair agents for the use in **food and beverage** packaging industry. In other words, any radiation curable compositions having excellent adherence to metals are suitable in the '760 publication.

Third, the '221 patent broadly teaches that compositions may be used for obtaining *conformal* coating on metal substrates (See column 1, lines 13-14) having *excellent adhesion to metal surfaces* (See column 11, line 34). Obviously, the *conformal* coating is resistant to solvent and chemicals since otherwise it could not be used as a coating on circuit boards, electrical components. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used UV-curable coating composition of Koleske as UV-curable repair agent of An et al with the expectation of providing the desired conformal coating having excellent adhesion to metal surfaces, as taught by Koleske, since An et al does not limit its teaching to a particular UV-curable coating composition.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not



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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENA Tsoy LIGHTFOOT whose telephone number is (571)272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.  
Primary Examiner  
Art Unit 1715

May 18, 2010

/Elena Tsoy Lightfoot/